

REMARKS

By the foregoing, claims 13, 20, 24, 28, 40, 42, 49, 52, 53, and 57 have been amended; claims 11-12, 22, and 51 were previously canceled; and claims 1-10, 30-39, and 59-73 were previously withdrawn. The Applicant submits that the amendments made herein are fully supported in the specification, claims and the drawings, as originally filed, and therefore no new matter has been introduced. Claims 13-21, 23-29, 40-50, 52-58, and 74-82 are subject to examination and pending in the present application.

II. Claims 13-19, 40-50, 52, 54-58

Claims 13-19, 40-50, 52 and 54-58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,449,330 issued to Lucas et al. ("Lucas") in view of U.S. Patent No. 5,146,552 issued to Cassorla et al. ("Cassorla") and further in view of U.S. Patent No. 5,467,102 issued to Kuno et al. ("Kuno"). The Applicant notes that claims 13, 40, and 42 have been amended. To the extent that this rejection applies to the claims, as amended, the Applicant respectfully traverses the rejection as follows.

Applicant's invention as now set forth in claim 13 is directed to a method for displaying at least one selected page of an electronic book displayed on a viewer having a plurality of hardware screens, each capable of being physically connected and disconnected, comprising formatting the selected page for display on the screens of the viewer.

The Examiner admits that the combination of Lucas and Cassorla fail to disclose or suggest an electronic book displayed on a viewer having a plurality of

hardware screens, each being capable of being connected and disconnected.

The Examiner relies on Kuno as teaching a switching mechanism that activates or deactivates hardware screens in Kuno for the display of information.

However, Kuno merely teaches a screen being electronically turned on or off for display. Kuno does not disclose or suggest displaying at least one selected page of an electronic book displayed on a viewer having a plurality of hardware screens, each capable of being **physically** connected and disconnected, as now claimed in claim 13.

For at least this reason, the Applicant respectfully submits that claim 13, as amended, is allowable over the cited art. For similar reasons, the Applicant submits that claims 40 and 42 are likewise allowable.

As amended claim 13 is allowable, the Applicant submits that claims 14-19 and 74-75, which depend from allowable claim 13, are likewise allowable for at least the above noted reasons and for the additional limitations they provide.

For similar reasons to those discussed with regard to claim 13, the Applicant submits that claims 40 and 42 are allowable over the cited art. As amended claims 40 and 42 are allowable, the Applicant submits that claims 41 and 43-48, each of which depends from one of allowable claims 40 or 42, are likewise allowable for at least the above noted reasons and for the additional limitations they provide.

II. Claims 20-21, 23-29, 53, and 76-82

Claims 20-21, 23, and 25-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas in view of Cassorla. Claims 24 and 53 are

rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas in view of Cassorla and further in view of U.S. Patent No. 5,625,833 to Levine et al. ("Levine"). It is noted that claims 20, 24, 28, 49, and 53 have been amended. To the extent that these rejections apply to the claims, as amended, the Applicant respectfully traverses the rejection as follows.

Applicant's invention as now set forth in claim 20 is directed to a method for simultaneously displaying on a viewer a selected portion of an electronic book and content from a **separate** information source comprising receiving a request from a subscriber for displaying at least a portion of the electronic book and, **afterward**, receiving a request for simultaneously displaying the content from a **separate** information source and displaying the content from the information source as an inset page, **fully inset** within the displayed portion of the electronic book.

Lucas teaches the display of pages of electronic documents in piles or tiles. The Examiner points to Lucas as disclosing "the displaying step includes displaying the content from the information source as an inset image within the displayed portion of the document". However, the Examiner does not address that the content is from a **separate** information source.

In addition, Lucas does not disclose or suggest receiving a request from a subscriber for displaying at least a portion of the electronic book and, afterward, receiving a request for simultaneously displaying the content from a separate information source, as claimed in amended claim 20.

Lucas teaches the documents displayed in piles or tiles, where the pages overlap each other. However, Lucas, also, does not disclose or suggest displaying the content from the information source as an inset page, **fully inset** within the displayed portion of the electronic book.

Cassorla and Levine do not cure the deficiencies in Lucas.

For at least these reasons, the Applicant submits that claim 20, as amended, is allowable over the cited art. As claim 20 is allowable, the Applicant submits that claims 21, 23- 29, and 76-79, which depend from claim 20, are likewise allowable for at least the above noted reasons and for the additional limitations they provide.

For similar reasons to those discussed with respect to claim 20, the Applicant submits that amended claims 24, 28, 49, 53 and 57 are allowable over the cited art. As amended claims 24, 28, 49, 53 and 57 are allowable, the Applicant submits that claims 25-27, 29, and 80-82, each of which depends from one of allowable claims 24, 28, or 53 are likewise allowable for at least the above noted reasons and for the additional limitations they provide.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to

do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at pages 4, 5, and 7-11. This is an insufficient showing of motivation.

III. Claims 74-82

The Examiner did not reject claims 74-82. Therefore, the Applicant assumes that claims 74-82 are allowable.

CONCLUSION

For all of the reasons set forth above, the Applicant respectfully submits that each of claims 13-21, 23-29, 40-50, 52-58, and 74-82 recite subject matter that is neither disclosed nor suggested in the applied art of record. The Applicant also submits that the subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore respectfully

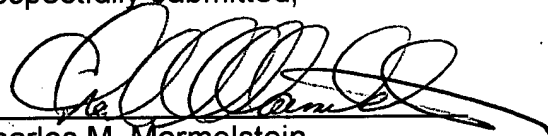
Application No.: 09/335,268
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requests that claims 13-21, 23-29, 40-50, 52-58, and 74-82 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300 referencing Attorney Docket No. 026880-00020.

Respectfully submitted,



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